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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

14374.106

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Application Number

10/668,537

Filed

September 23, 2003

First Named Inventor

Warburton

Art Unit

1775

Examiner

2130

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 45,576

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Peter F. Malen, Jr.
Typed or printed name

801-533-9800
Telephone number

May 23, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Warburton

) Art Unit

) 1775

2130

Ling X. Xu

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In reply to the Final Office Action mailed March 13, 2006, Applicants respectfully request a panel review of the final rejection under 35 U.S.C. §§ 112 (first paragraph), 102(b) and 103(a) discussed in the remarks below. No amendments are being filed with this Request. This Request is being filed concurrently with a Notice of Appeal.

Claims 1-36 are currently pending in the application. Claims 1-36 have been finally rejected under 35 U.S.C. § 112, first paragraph as purportedly failing to comply with the enablement requirement. Claims 1-2, 4-15 and 17-19 have been finally rejected under 35 U.S.C. §§ 102(b) or 103(a), respectively, as purportedly being anticipated by, or obvious over, US 3,400,882 to McManus (“*McManus*”). Claims 1-2 and 4-10 have been finally rejected under 35 U.S.C. §§ 102(b) or 103(a), respectively, as purportedly being anticipated by, or obvious over, US 6,329,098 to Bliesner (“*Bliesner*”). Claims 3, 16 and 20-26 have been finally rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over *McManus* as applied to claims 1-2, 4-15 and 17-19, and further in view of US 5,725,808 to Tormey et al. (“*Tormey*”). Finally, claim 3 has been finally rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over *Bliesner* as applied to claims 1-2, and further in view of *Tormey*.

Legal and Factual Deficiencies

1. Claim rejections based upon 35 U.S.C. § 112, first paragraph

As noted in Applicant's paper filed on March 9, 2006 (section III, pp. 10-11) ("Applicant's March 9, 2006 Paper"), the Examiner failed to correctly state the test for enablement in the Office Action mailed August 19, 2005. In Applicant's March 9, 2006 Paper, Applicant traversed the rejection of the Examiner on that ground. In the Final Office Action mailed March 13, 2006, the Examiner did not address the arguments set forth by Applicant in the paper filed March 9, 2006, but simply repeated the earlier rejection, again incorrectly stating the enablement test. In this regard, Applicant notes that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, *take note of the applicant's argument and answer the substance of it.*" *M.P.E.P. § 707.07(f). Emphasis added.* Moreover, Applicant noted in the aforementioned traversal that the rejection appeared to be based at least in part on the personal knowledge of the Examiner, and Applicant accordingly requested an affidavit pursuant to 37 C.F.R. 1.104(d)(2). See *Applicant's March 9, 2006 Paper at 11*. However, the Examiner did not provide the requested affidavit.

In any case, it is clear that the test for enablement is not, contrary to the assertion of the Examiner, simply whether the claimed invention "was described sufficiently in the specification to enable one skilled in the art to make and use the invention." Rather, it is well established that "The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In Re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)." *MPEP § 2164.01. Emphasis added.* In light of the foregoing, Applicant respectfully submits that the enablement test articulated by the Examiner in the Office Action mailed August 19, 2005 is plainly inconsistent with longstanding U.S. Supreme Court and Federal Circuit precedent.

As further noted in Applicant's March 9, 2006 Paper (pp. 10-11), the examination guidelines provide that "there are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any experimentation is 'undue.' *MPEP § 2164.01(a). Emphasis added.* In connection with the foregoing, the examination guidelines further provide that "It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *Id. Emphasis added.* As to the aforementioned factors, the examination guidelines explain that "The determination that 'undue

experimentation' would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations." *Id. Emphasis added.* Applicant respectfully submits that it is clear from the Final Office Action mailed March 13, 2006, and from the preceding Office Actions, that the Examiner has not performed the required analyses.

As the foregoing makes clear, the Examiner has not only failed to properly state the test for enablement, but the Examiner has likewise failed to address the issue of undue experimentation as such is contemplated by the enablement test. For at least those reasons, Applicant respectfully submits that the rejection of claims 1-36 under 35 U.S.C. § 112, first paragraph lacks an adequate basis and should be withdrawn.

2. Claim rejections based upon 35 U.S.C. § 102(b)

Claims 1-2, 4-15 and 17-19 have been rejected as being anticipated by *McManus* and/or *Bliesner*. Applicant disagrees for at least the reasons set forth in Applicant's March 9, 2006 Paper (section IV, pp. 11-14). As noted there, the rejected claims recite "a coating substantially comprising an inorganically bonded ceramic." In contrast, the portion of *McManus* relied on by the Examiner refers only to a "vacuum chamber comprising a coating of ceramic material ... which may be any suitable ceramic ..." (col. 3, lines 60-75), and the portion of *Bliesner* relied on by the Examiner refers only to an "electrically insulating ceramic ..." (col. 3, line 12). Thus, the respective portions of *McManus* and *Bliesner* relied upon by the Examiner clearly fail to disclose the "inorganically bonded" ceramic recited in the claims.

Notwithstanding such failure, the Examiner has asserted that Hawley's Condensed Chemical Dictionary, 13th Edition, p. 231 ("*Hawley's*") defines a ceramic as "a product, in which silicon and its oxide and complex compound known as silicates occupy a predominant position." The Examiner goes on to extrapolate, without citing any supporting references or data, that "since ceramic comprises inorganic materials, ceramic is considered to be inorganically bonded ceramic." *Emphasis added.* As characterized by the Examiner then, all silicon, silicon oxides and silicates are inorganic. Again however, the Examiner has provided no support for this characterization. The Examiner then concludes that the "ceramic" coatings referred to in *McManus* and *Bliesner* necessarily comprise "inorganically bonded ceramic" as recited in the rejected claims.

As noted in Applicant's March 9, 2006 Paper (section IV, pp. 13-14) however, this conclusion is not supported by *Hawley's*. For example, and contrary to the assertion of the Examiner, it is well established that organic silicates exist. See *Id.* Applying the *Hawley's* definition then, "ceramic" would seem to embrace not only inorganic ceramics, but also organic ceramics such as those predominantly composed of an organic silicate.

In light of the foregoing, Applicant submits that there is no basis for the narrow construction advanced by the Examiner with respect to the term “ceramic.” At least insofar as the Examiner has failed to establish that *Hawley’s* discloses that all ceramics are inorganic, *Hawley’s* fails to provide support for the rejection advanced by the Examiner. That is, the mere possibility that *Hawley’s* discloses inorganic ceramics is inadequate to support a conclusion that the ceramics referred to in *McManus* and *Bliesner* are necessarily inorganic. Applicant thus respectfully submits that the Examiner has failed to establish that *McManus* or *Bliesner*, considered in connection with *Hawley’s*, disclose the identical invention in as complete detail as is contained in the claims. See *MPEP* § 2131.

In connection with the foregoing, Applicant notes as well that in Applicant’s March 9, 2006 Paper, Applicant traversed the rejection of the Examiner on the aforementioned basis. In the Final Office Action mailed March 13, 2006 however, the Examiner failed to address the arguments set forth by Applicant in Applicant’s March 9, 2006 Paper, and simply repeated the earlier rejection. In this regard, Applicant notes that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, *take note of the applicant’s argument and answer the substance of it.*” *M.P.E.P.* § 707.07(f). *Emphasis added.*

Finally, Applicant noted in the aforementioned traversal that the rejection appeared to be based at least in part on the personal knowledge of the Examiner and Applicant accordingly requested an affidavit pursuant to 37 C.F.R. 1.104(d)(2). See *Applicant’s March 9, 2006 Paper* at 14. However, the Examiner did not provide the requested affidavit.

For at least the reasons set forth above, Applicant respectfully submits that the Examiner has failed to establish that either *McManus* or *Bliesner* anticipate claims 1-2, 4-15 and 17-19 under 35 U.S.C. § 102(b), and the rejection of those claims should accordingly be withdrawn.

3. Claim rejections based upon 35 U.S.C. § 103(a)

Claims 1-36 have been rejected under 35 U.S.C. § 103(a) as being obvious over one or more of *McManus*, *Bliesner* and *Tormey*. As noted at 2. above, and in Applicant’s March 9, 2006 Paper (p. 14) however, the Examiner has failed to establish that either *McManus* or *Bliesner* teaches, or even suggests, the claimed “inorganically bonded ceramic.” Thus, even if the cited references are combined in the purportedly obvious fashion, the resulting combinations fail to include all the limitations of the rejected claims. Moreover, in the rejection based solely on *McManus*, and in the rejection based solely on *Bliesner*, the Examiner has failed to even state what the purportedly obvious combination is, much less establish the existence of a motivation to make such a combination. See *Office Action mailed February 4, 2005 at 4-6.*

As to the rejections based on, respectively, the purportedly obvious combinations of *McManus* and *Tormey*, and *Bliesner* and *Tormey*, the Examiner has asserted that such combinations are obvious "... in order to improve the properties of the ceramic coating such as reduced shrinkage and have a low firing temperature." *Office Action mailed February 4, 2005 at 7. Emphasis added.*

Applicant notes however that "improve[d] properties," "reduced shrinkage" and "low firing temperature" are relative terms whose definitions are known only to the Examiner. For example, it is not apparent what reference point(s) the Examiner is using as a basis to assert that such improvements and reductions would be achieved as a result of the implementation of the purportedly obvious combination.

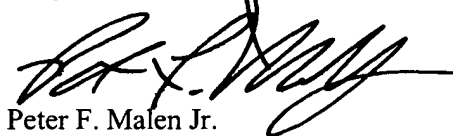
Further, the Examiner has failed to establish that either the *Bliesner* or *McManus* coatings suffers from such shortcomings as could, or would, be remedied by use of the purported disclosure of *Tormey*. In the absence of any evidence that the *Bliesner* or *McManus* coatings are somehow deficient in terms of their shrinkage and firing temperature characteristics, if any, Applicant submits that the Examiner has failed to establish existence of the requisite motivation to make the purportedly obvious combination.

In light of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-36, at least because even if the references are combined in the purportedly obvious fashion, the resulting combinations fail to include all the limitations of the rejected claims, and because the Examiner has not established the existence of a motivation to make the allegedly obvious combinations.

Because the rejections set forth in the Final Office Action include a variety of legal and factual deficiencies, Applicants are entitled to a pre-appeal brief review of the Final Office Action. Moreover, in view of the foregoing remarks, Applicants respectfully request withdrawal of finality of the rejection, reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Dated this 23rd day of May, 2006.

Respectfully submitted,



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